

REMARKS

Summary of the Office Action

Claims 1 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,560,529 to *Udagawa et al.* ("*Udagawa*").

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Udagawa* in view of German Patent No. DE 84519 ("*DE'519*") or U.S. Patent No. 4,770,334 to *Hoshi et al.* ("*Hoshi*").

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all features of the base claim and any intervening claims.

Summary of the Response to the Office Action

Claim 14 is rewritten in independent form, claim 1 is amended to include the features of claim 15, and claim 15 is cancelled without prejudice or disclaimer. Claims 3-13 have been withdrawn as the result of the restriction requirement. Claim 1-2 and 14 are pending for consideration.

Allowable Subject Matter

Applicants wish to thank the Examiner for indicating allowable subject matter in claim 14. Therefore, claim 14 has been rewritten in independent form.

The Rejections Under 35 U.S.C. § 102(b)

Claims 1 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Udagawa*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Udagawa* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 1 recites, in part, "wherein said peripheral face of the rolled staple is an outer circumference of a wound portion of the rolled staple where the staples are wound, and the feeding roller is in contact with the outer circumference of the wound portion." *Udagawa* fails to teach or suggest at least these features of claim 1.

The Office Action argues that the staple feed roller 43 of *Udagawa* corresponds to the claimed "feeding roller" and that the Fig. 9 discloses the claimed rolled staple. However, Applicants respectfully submit that the staple feed roller 43 as disclosed in Fig. 8 is a roller that is in contact with a flat portion of a staple sheet, and not "a wound portion" as recited in claim 1. In Fig. 9, the roller 43 is not even disclosed. That is, neither Fig. 8 nor Fig. 9 discloses that "the feeding roller is in contact with the outer circumference of the wound portion," as recited in claim 1. Accordingly, *Udagawa* fails to teach or suggest each and every feature of claim 1. Thus, the rejection of claim 1 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of*

California, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Udagawa* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that the rejection of dependent claim 15 is moot in light of its cancellation, and the incorporation of its features into independent claim 1.

The Examiner's reasoning in the Advisory Action dated February 27, 2009, for issuing an advisory because new matter has been added to claim 1 and this constitutes a patentably distinct invention. Applicants respectfully submit that no new matter has been added. The same features present in claim 15 are now found in claim 1. The "stapling apparatus" with "rolled staple" features need not be subjected to further restriction or amendment.

The Rejections Under 35 U.S.C. § 103(a)

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Udagawa* in view of *DE'519* or *Hoshi*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Udagawa* in view of *DE'519* or *Hoshi* teaches each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 103(a) should be withdrawn. Newly amended independent claim 1 recites, in part, "wherein said peripheral face of the rolled staple is an outer circumference of a wound portion of the rolled staple where the staples are wound, and the feeding roller is in contact with the outer circumference of the wound portion." As demonstrated

above, *Udagawa* fails to teach or suggest at least these features of claim 1. Both *DE'519* and *Hoshi* are relied upon only for a teaching of "teeth" for a feeding roller. Therefore, both *DE'519* and *Hoshi* do not make up for the above-mentioned deficiencies of *Udagawa*. Thus, the features of claim 1 are not obvious over the cited art.

Additionally, Applicants respectfully submit that dependent claim 2 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

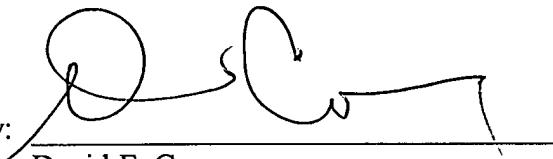
CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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